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Remarks:

Claims 1-19 and 34-37 are pending in the present application. Claims 1, 5-7, 13, 17 and 34-37 have been amended. No new matter is introduced by the amendments. The claim amendments and reply satisfy the submission requirement for Request for Continued Examination under 37 CFR 1.114, as specified in MPEP 706.07 (h). Reconsideration of the rejection of the claims is respectfully requested.

Claim Rejections

Claims 1-19 and 33-37 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Applicants' admission either individually, or in view of U.S. Patent No. 3,839,078 to Birchall et al. ("Birchall").

In the Examiner's Answer in response to the Appeal Brief filed 2/14/05, the Examiner states that

in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to modify Applicants' admitted prior art by incorporating a commonly practiced anchor layer of isocyanate-ended polyurethane or vinylidene chloride-alkyl acrylate copolymer between the reinforcing PET film substrate and the polyurethane foam layer, motivated by the desire to obtain an improved adhesion between the layers, so as to alleviate the known delamination problem upon the removal of the printing plate from the used tape.

(Examiner's Answer, page 4, lines 5-12)

It is the Examiner's position that the mechanism preventing delamination failure by the anchor layer is either inherent or obviously provided once the same product as the claim is made.

(Examiner's Answer, page 6, lines 17-20).

However, the Examiner admits that

if the delamination is indeed caused by cohesive failure of the PET film, there is lack of motivation to use an anchor layer to improve cohesive strength, because it is a bulk property, not surface property, of a polymer, and it appears that Appellants' solution to solve the delamination problem is incommensurate use of an anchor layer, nonetheless.

(Examiner's Answer, page 8, lines 12-16).

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Applicants respectfully request reconsideration of the rejection in view of the above amendments to the claims. As amended, independent claims 1, 13 and 17 recite a polymer layer, and specifically require the polymer layer to prevent cohesive failure of the reinforcing film. Dependent claims 5-7, and 34-37 have been amended to be consistent with the independent claims and the specification. Support for the amendments is found throughout the specification, beginning at least at Page 4, lines 5-9.

Appellants contend that Birchall fails to provide a motivation to use a polymer layer between the claimed polyurethane foam and composite reinforcing film in a foam cushion tape to improve the cohesive strength of the reinforcing film, and fails to provide any expectation of success in so doing. As stated in the specification, and shown in the Declaration of Brett Kilhenny dated July 3, 2003, failure of the claimed foam cushion tapes upon removal from a drum is not due to insufficient adhesion between the polyurethane foam and the composite reinforcing layer. The failure is due, instead, to weak cohesive strength at the surface of the reinforcing layer itself.

In contrast, Birchall teaches use of an intermediate adhesion promoting layer between a film substrate and a superstrate. Such layers are used when the adhesion between the substrate and the superstrate are insufficient. As stated by Birchall:

For many applications of films it is desirable to provide a film substrate with a superstrate of another material. . . . However, it is difficult to develop sufficient adhesion between the film substrate and superstrate which will be maintained during subsequent processing and usage of the film.

(Birchall, col. 21, line 61 to col. 22, line 4.)

Given that the problem to be solved was failure of the reinforcing film, and not the strength of the bond between the reinforcing film and the polyurethane foam, the inventors simply had no motivation to use an "adhesion promoting" layer where the apparent problem was the strength of the one of the layers to be adhered. Moreover, the present polymer layer functions to prevent cohesive failure of the reinforcing film.

Just as there is no motivation to use an "adhesion promoting" layer where the apparent problem was the strength of the one of the layers to be adhered, the inventors certainly had no expectation of success in so doing. The requirement for a determination of obviousness is that "both the suggestion and the expectation of success must be founded in the prior art, not in

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applicant's disclosure" (emphasis added). *In re Dow Chem.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Birchall discloses that anchoring layers can be used as adhesion promoting layers between a film substrate and a superstrate that do not have "sufficient adhesion". The problem to be solved by the invention was not insufficient adhesion, but insufficient cohesive strength of the film layer when used in combination with a foam. There is no reason to expect that use of an anchoring layer would improve the apparent cohesive strength of the reinforcing film. This is particularly so based on Birchall's teaching that anchoring layers are commonly used in connection with "organic plastics films" and not polyurethane foams as is presently claimed. The specification and Birchall therefore do not provide any motivation to make the suggested combination, and no expectation of success if such combination were made.

Applicants further suggest that such results cannot be inherent in Birchall. An inherent feature necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). A finding of inherency cannot be made where it flows as simply a possible conclusion from the teachings of the prior art. Birchall merely teaches that the disclosed anchoring layers can be used to improve adhesion between "organic plastics films", such as those used in packaging or as a photographic film base, together with "superstrates" such as a heat-sealable coating (col. 21, lines 59-68). The Examiner has provided no technical or factual grounds for any assertion that use of an adhesion promoting layer with the substrates and superstrates of Birchall would necessarily result in improved cohesive strength at the surface of one of the layers. The improved results are therefore not inherent in Birchall.

Applicants believe that the present claim amendments and arguments fully address the outstanding rejections. Applicants therefore respectfully request reversal of the rejections and allowance of claims 1-19 and 34-37.

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If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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